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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,595	03/11/2004	Li-Ying Yang	FDN-2795	6367

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03/14/2008

EXAMINER

KATCHEVES, BASIL S

ART UNIT

PAPER NUMBER

3635

MAIL DATE

DELIVERY MODE

03/14/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/798,595

Applicant(s)

YANG ET AL.

Examiner

BASIL KATCHEVES

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 2-4, 6, 7, 19-21, 23 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 8-18, 22 and 25-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3/11/04, 8/7/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of claims 1, 5, 8-18, 22, 25-31 in the reply filed on 12/20/07 is acknowledged.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 27, the phrase "extruding/calendering" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed, thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Claim 28 recites the limitation "said coating" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

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F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 8, 10, 12, 13, 15 and 25 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,544,909. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claims 1, 8, 10, 12, 13, 15 and 25 are substantially similar to claim 1 of '909.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, 10, 11, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,134,856 to Khan et al.

Regarding claim 1, 10, 11, Khan discloses a roofing membrane (title) having a top and bottom layer (fig. 1: 14 & 16) and a scrim layer (12) made of fiberglass (column 2,

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lines 17-26), the bottom layer being embossed with alternating ridges and valleys, The layers pressed into one. Regarding the mechanically embossed limitation, the applicant should note that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

Regarding claim 5, Khan discloses the embossment pattern as random (fig. 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 9, 12, 14-18, 25-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,134,856 to Khan et al.

Regarding claims 8, 9, 25, Khan does not specifically disclose the top and bottom layers as being a polyolefin from polypropylene. However, Khan discloses the layers as optionally being polypropylene (column 2, lines 27-31). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use

polypropylene, since it is an option disclosed by Khan and would have been an obvious design choice.

Regarding claim 12, Khan discloses the basic claim structure of the instant application but does not disclose specific dimensions of polyolefin (polypropylene) as stated in the claims. Applicant fails to show criticality for specifically claimed dimensions, therefore it would have been an obvious design choice to use the dimensions such as specified in these claims.

Regarding claim 14-18, Khan discloses the basic claim structure of the instant application but does not disclose specific dimensions. Applicant fails to show criticality for specifically claimed dimensions, therefore it would have been an obvious design choice to use the dimensions such as specified in these claims.

Regarding claim 26, Khan discloses a roofing membrane (title) having a top and bottom layer (fig. 1: 14 & 16) and a scrim layer (12) made of fiberglass (column 2, lines 17-26), the bottom layer being embossed with alternating ridges and valleys, Khan also discloses the making of the ply by applying the top and bottom in molten states (column 1, line 50) but not mechanical embossing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to mechanically emboss the layers, since it is easier to apply a force to create a desired shape than to chemically create the same shape.

Regarding claim 27-29, Khan does not disclose the molten ply as being extruded. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use an extruding means to create the ply since extrusion (and

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pultrusion) is a common and standard way of shaping synthetic materials. The polyolefin being polypropylene (column 2, line 28).

Regarding claims 30, 31, Khan discloses the ply as being capable of rolled (title) and for use on a roof (title). It would have been obvious to one having ordinary skill in the art at the time the invention was made to unroll the rolled roofing material upon a roof and secure it by fasteners to the roof, since that is the only way roofing material may be used upon a roof.

Claims 13, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,134,856 to Khan et al. in view of U.S. Patent No. 4,695,501 to Robinson.

Regarding claim 13, Khan does not disclose the polyolefin as being of the group claimed by the applicant. Robinson discloses an insulative material having polyolefins of various types, One being epoxy polyethylene (column 3, lines 29-48). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Khan by using such a material since it is used as a flexible, insulative sheet.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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The cited patents listed on the included form PTO-892 further show the state of the art with respect to roofing material in general.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Basil Katcheves whose telephone number is (571) 272-6846. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot, can be reached at (571) 272-6777.

/Basil Katcheves/

Primary Examiner, Art Unit 3635